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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission: 13

Application Number	09/909,630
Filing Date	July 19, 2001
First Named Inventor	Yakov Kamen
Art Unit	2676
Examiner Name	Antonio A. Caschera
Attorney Docket Number	091451.000146

ENCLOSURES *(Check all that apply)*

- [x] Fee Transmittal Form
  - [x] Fee Attached
- [ ] Amendment/Reply
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [ ] Reply to Missing Parts/ Incomplete Application
  - [ ] Reply to Missing Parts under 37 CFR 1.52 or 1.53
- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
- [ ] Terminal Disclaimer
- [ ] Request for Refund
- [ ] CD, Number of CD(s) _____
  - [ ] Landscape Table on CD
- [ ] After Allowance Communication to TC
- [ ] Appeal Communication to Board of Appeals and Interferences
- [x] Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- [ ] Proprietary Information
- [ ] Status Letter
- [x] Other Enclosure(s) (please Identify below):

Postcard

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Holland & Knight LLP		
Signature	Michael J. Buchenhorner		
Printed name	Michael J. Buchenhorner		
Date	May 3, 2006	Reg. No.	33,162

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Signature	Michael J. Buchenhorner		
Typed or printed name	Michael J. Buchenhorner	Date	May 3, 2006

PTO/SB/17 (01-06)
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
For FY 2006

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($) 500.00

Complete if Known	
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METHOD OF PAYMENT (check all that apply)

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☑ Deposit Account Deposit Account Number: 50-2870 Deposit Account Name: Holland & Knight LLP

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1. BASIC FILING, SEARCH, AND EXAMINATION FEES

	FILING FEES		SEARCH FEES		EXAMINATION FEES		
		Small Entity		Small Entity		Small Entity	
Application Type	Fee ($)	Fee ($)	Fee ($)	Fee ($)	Fee ($)	Fee ($)	Fees Paid ($)
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee ($)	Small Entity Fee ($)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims		Extra Claims	Fee ($)	Fee Paid ($)
_____	- 20 or HP =	_____	x _____	= _____

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims		Extra Claims	Fee ($)	Fee Paid ($)
_____	- 3 or HP =	_____	x _____	= _____

HP = highest number of independent claims paid for, if greater than 3.

Multiple Dependent Claims	
Fee ($)	Fee Paid ($)
_____	_____

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets		Extra Sheets		Number of each additional 50 or fraction thereof	Fee ($)	Fee Paid ($)
_____	- 100 =	_____	/ 50 =	_____ (round up to a whole number)	x _____	= _____

4. OTHER FEE(S)

	Fees Paid ($)
Non-English Specification, $130 fee (no small entity discount)	500.00
Other (e.g., late filing surcharge): Appeal Brief	

SUBMITTED BY

Signature	Michael J. Buchenhorner	Registration No. (Attorney/Agent) 33,162	Telephone 305-789-7773
Name (Print/Type)	Michael J. Buchenhorner		Date May 3, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Yakov Kamen	Art Unit	: 2676
Serial No.	: 09/909,630	Examiner	: Antonio A. Caschera
Filed	: July 19, 2001		
Title	: Method and System for Modification of EPG Object Attributes		

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

(1) Real Party in Interest

The real party in interest is the assignee, ISurfTV Corporation.

(2) Related Appeals and Interferences

None known.

(3) Status of Claims

Claims 1-30 are pending in the case. (See Appendix of Claims) Claims 1-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kohno (U.S. Patent 6,462,784) in view of Microsoft Sound Recorder 4.0, Software included in Microsoft Windows, Microsoft Corporation (1981, 1998) or Bedard (U.S. Patent 5,793,438). All of the pending claims are being appealed.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

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May 3, 2006
Date of Deposit

Michael J. Buchenhorner
Signature

Michael J. Buchenhorner
Typed or Printed Name of Person Signing Certificate

(4) Status of Amendments

No substantive amendments have been made since the final office action dated November 29, 2005.

(5) Summary of Claimed Subject Matter

Claim 1 relates to a method for: selecting an object displayed in an EPG [paragraph 14, lines 3-4]; modifying an attribute associated with the object by an incremental amount for each of at least more than two times that the object is selected [paragraph 14, lines 6-7], wherein modification of the attribute occurs at least more than two times in a common direction and each change in the attribute is a change in a visible characteristic of the attribute [paragraph 11, lines 11-13, royal blue to navy blue to a dark midnight blue]; and modifying the display of the object in accordance with the modified attribute [step 214, paragraph 14, lines 12-14].

Claim 11 relates to a system comprising: a first unit for selection of an object displayed in an EPG [object 101a, paragraph 10, line 9]; a second unit to modify an attribute associated with an object by an incremental amount for each of at least more than two times that the object is selected [paragraph 11, lines 9-13], wherein modification of the attribute occurs at least more than two of times in a common direction and each change in the attribute is a change in a visible characteristic of the attribute [paragraph 11, lines 11-13, royal blue to navy blue to a dark midnight blue]; and a third unit to modify the display of the object in accordance with the modified attribute [paragraph 14, lines 11-12].

Claim 21 relates to a machine-readable storage medium [paragraph 17, lines 1-2] embodying a sequence of instructions executable by the machine [paragraph 17, lines 2-4] to perform a method for modifying display information, the method comprising: an object displayed in an EPG [object 101a, paragraph 10, line 9]; modifying an attribute associated with

the object [paragraph 14, lines 6-7] by an incremental amount [paragraph 14, lines 7-8] for each of at least more than two times that the object is selected, wherein modification of the attribute occurs at least more than two times in a common direction and each change in the attribute is a change in a visible characteristic of the attribute [paragraph 11, lines 9-13]; and modifying the display of the object in accordance with the modified attribute [paragraph 14, lines 8-12].

Claims 2, 12, and 22 require that the attribute is a color that is darkened or lightened [paragraph 11, line 11]. Claims 3, 13, and 23 require that the attribute is a shape [paragraph 12, line 1]. Claims 4, 14, and 24 require that the attribute is a 3-D position [paragraph 12, line 2]. Claims 5, 15, and 25 require that the modified attribute is overwritten with a default attribute when an expiration value limit is reached [paragraph 15, lines 4-6]. Claims 6, 16, and 26 require that expiration value limit is a time limit [paragraph 15, lines 3-4]. Claims 7, 17, and 27 require that the expiration value limit is related to frequency of object selection [paragraph 16, lines 5-6]. Claims 8, 18 and 28 require that the object is a channel selection field [Fig. 1, items 101a-n, paragraph 10, lines 6-7]. Claims 9, 19, and 29 require that the object is a programming time slot field [Fig. 1, items 102a-n, paragraph 10, lines 8-9]. Claims 10, 20, and 30 require that the object is a programming event information field [Fig. 1, items 103, paragraph 10, lines 9-10].

(6) Grounds of Rejection to be Reviewed on Appeal

The ground of rejection to be reviewed on appeal is:

A. Did the examiner properly reject claims 1, 2, 11, 12, 21, and 22 under 35 U.S.C. §103 as unpatentable over Kohno in view of Microsoft Sound Recorder 4.0, Software included in Microsoft Windows, Microsoft Corp. (1981, 1998)?

B. Did the examiner properly reject claims 3-10, 13-20, and 23-30 under 35 U.S.C. §103 as unpatentable over Kohno in view of Microsoft Sound Recorder, and further in view of Bedard (U.S. Patent 5,793,438)?

(7) Argument

A. The examiner did not properly reject claims 1, 2, 11, 12, 21, and 22 under 35 U.S.C. §103 as unpatentable over Kohno in view of Microsoft Sound Recorder.

A claimed invention is unpatentable if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. 103(a) (Supp. 1998); *see Graham v. John Deere Co.*, 383 U.S. 1, 14, 148 USPQ 459, 465 (1966). The ultimate determination of whether an invention is or is not obvious is a legal conclusion based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *See Graham*, 383 U.S. at 17-18, 148 USPQ at 467; *Miles Labs, Inc., Inc. v. Shandon Inc.*, 997 F.2d 870, 877, 27 USPQ2d 1123, 1128 (Fed. Cir. 1993). The time that is critical is when the invention was made. Use of evidence after that is considered to be improper hindsight. The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness

holding"). Evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, *see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), *Para-Ordinance Mfg. v. SGS Imports Intern., Inc.*, 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. *In re Dembiczak*, 75 F.3d 994, 50 USPQ2d, 1614 (Fed. Cir. 1999).

The prior art references of record, whether considered alone or in combination, fail to either teach or suggest Applicant's claimed invention. More specifically, Applicant's claimed invention requires providing an incremental change in an attribute associated with the object for each of a plurality of times that the object has been selected (see claims 1, 11, and 21). Consequently, an object's attribute such as, for example, the color of the object (see claims 2, 12, and 22) is incrementally changed from an original to a incrementally (gradually) increasing or decreasing shade of color each time the object is selected. In contrast, the prior art references merely disclose two operating states for an object, one state with a first attribute when the object is selected and another state with a second attribute when the object is not selected. Applicant submits that the prior art references of record provide no evidence of any teaching or suggestion whatsoever regarding this advance in the art.

More specifically, with respect to claim 1 the attribute is modified by an "incremental amount" each time the object is selected. The examiner interprets "incremental amount" as the

changing of the color of the key in the Microsoft Sound Recorder which admittedly has only two tones and is used only to show the state of the switch. That is not a reasonable interpretation in view of Applicant's use of the term in the specification. As the Examiner concludes, the Kohno reference, either alone or in combination, simply does not disclose or suggest modifying an attribute incrementally in a common direction to change the attribute of the object each time the object is selected for a plurality of selections.

In order to overcome this deficiency in Kohno, the Examiner asserts that the Microsoft Sound Recorder discloses modification of the play button's attribute from an enabled state to a disabled state. Furthermore, the Microsoft Sound Recorder discloses changing a the color of the play button from black in the enabled state to gray in the disabled state and back again to black when the button is re-enabled. First, Applicants note that combining references in order to defeat patentability has not been allowed by the Federal Courts unless evidence of a teaching or suggestion of such a combination is present. The U.S. Court of Appeals for the Federal Circuit held in *Dembiczak* that "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability." *In re Dembiczak, supra.* In this case, there is no evidence of a suggestion or motivation for the combination of the Microsoft Sound Recorder interface with Kohno or any other electronic program guide reference and the examiner does not cite any such evidence. Consequently, such a combination is inappropriate.

Second, the Microsoft Sound Recorder simply discloses a two state play button. The Examiner correctly notes that the play button merely changes from black to grey when selected and reverts back to black. That is two states: grey and black. This is an abrupt change that

significantly different from the present invention which **incrementally** changes an object's attribute, i.e. gradually changes the attribute multiple times wherein each change is associated with a selection of the object. For example, an embodiment of the invention elaborates on the meaning of "incremental amount" where the attribute of an object is changed from royal blue to navy blue and then to midnight blue. See specification at page 6, paragraph 11, lines 11-13. Therefore, Microsoft Sound Recorder 4.0, either alone or in combination with Kohno, fails to teach the advances in the present invention as expressed in independent claims 1, 11, 21 and their respective dependent claims. Moreover, in claims 2, 12, and 22 in combination with their parent claims require that the color of the attribute be modified in incremental amounts. For reasons discussed above the cited combination of references does not teach or suggest these limitations.

B. The examiner did not properly reject claims 3-10, 13-20, and 23-30 under 35 U.S.C. §103 as unpatentable over Kohno in view of Microsoft Sound Recorder, and further in view of Bedard.

First, for reasons provided above, the combination of Kohno and Microsoft Sound Recorder do not teach or suggest the limitations of the independent claims and at least for those reasons these claims which are all dependent on the above claims are not unpatentable over the cited references. Moreover, Bedard does not teach or suggest any of the additional limitations in combination with the respective independent claims. Bedard relates to making optimal use of available screen area in presenting automatic program guide information. The examiner cited col. 2, lines 15-19 but that section speaks generally of a magnified representation of a time window. It does not teach or suggest its combination with Kohno or Microsoft Sound Recorder type of features at all let alone with the specificity that the Federal Circuit requires. Second,

claims 3, 13, and 23 all require the attribute is a shape. The cited combination of references does not teach or suggest modifying a shape. Claims 4, 14, and 14 all require that the attribute is a 3_D position. Bedard shows an enlarged view of a small part of the screen, it does not show a 3-D position that is modified in an incremental amount as claimed. Claims 5, 15 and 25 require that the modified attribute is overwritten with a default attribute when an expiration value limit is reached. In Bedard there simply is no teaching of a default after a timeout period. Claims 6, 16, and 26 require that the expiration value limit is a time limit. Bedard neither teaches nor suggests this feature or its combination with the other references for the foregoing reasons. Claims 7, 17, and 27 Claims 7, 17, and 27 require that the expiration value limit is related to frequency of object selection. Applicant's claimed invention advantageously allows users to readily identify how often an object has been selected, and beyond simply knowing when the object has been selected, the user is provided with information concerning the number of selections of that object. The examiner did not explain how Bedard teaches this limitation whether or not in combination with the other references. Claims 8, 18 and 28 require that the object is a channel selection field. Claims 9, 19, and 29 require that the object is a programming time slot field. Claims 10, 20, and 30 require that the object is a programming event information field. All of these limitations are claimed in combination with the respective independent claim and are not rendered obvious by Bedard which does not teach or suggest its combination with the other references.

The brief fee of $500 is enclosed. Please apply any other charges or credits to Deposit Account No. 50-2870.

Respectfully submitted,

Date: May 3, 2006

Michael J. Buchenhorner

Appendix of Claims

1. A method comprising:

   (a) selecting an object displayed in an EPG;

   (b) modifying an attribute associated with the object by an incremental amount for each of at least more than two times that the object is selected, wherein modification of the attribute occurs at least more than two times in a common direction and each change in the attribute is a change in a visible characteristic of the attribute; and

   (c) modifying the display of the object in accordance with the modified attribute.

2. The method of claim 1, wherein the attribute is a color that is darkened or lightened.

3. The method of claim 1, wherein the attribute is a shape.

4. The method of claim 1, wherein the attribute is a 3-D position.

5. The method of claim 1, wherein the modified attribute is overwritten with a default attribute when an expiration value limit is reached.

6. The method of claim 5, wherein the expiration value limit is a time limit.

7. The method of claim 5, wherein the expiration value limit is related to frequency of object selection.

8. The method of claim 1, wherein the object is a channel selection field.

9. The method of claim 1, wherein the object is a programming time slot field.

10. The method of claim 1, wherein the object is a programming event information field.

11. A system comprising:

a first unit for selection of an object displayed in an EPG;

a second unit to modify an attribute associated with an object by an incremental amount for each of at least more than two times that the object is selected, wherein modification of the attribute occurs at least more than two of times in a common direction and each change in the attribute is a change in a visible characteristic of the attribute; and

a third unit to modify the display of the object in accordance with the modified attribute.

12. The system of claim 11, wherein the attribute is a color that is darkened or lightened.

13. The system of claim 11, wherein the attribute is a shape that is modified.

14. The system of claim 11, wherein the attribute is a 3-D position.

15. The system of claim 11, wherein the modified attribute is overwritten with a default attribute when an expiration value limit is reached.

16. The system of claim 15, wherein the expiration value limit is a time limit.

17. The system of claim 15, wherein the expiration value limit is related to frequency of object selection.

18. The system of claim 11, wherein the object is a channel selection field.

19. The system of claim 11, wherein the object is a programming time slot field.

20. The system of claim 11, wherein the object is a programming event information field.

21. A machine-readable storage medium embodying a sequence of instructions executable by the machine to perform a method for modifying display information, the method comprising:

(a) an object displayed in an EPG;

(b) modifying an attribute associated with the object by an incremental amount for each of at least more than two times that the object is selected, wherein modification of the attribute occurs at least more than two times in a common direction and each change in the attribute is a change in a visible characteristic of the attribute; and

(c) modifying the display of the object in accordance with the modified attribute.

22. The machine-readable medium of claim 21, wherein the attribute is a color that is darkened or lightened.

23. The machine-readable medium of claim 21, wherein the attribute is a shape that is modified.

24. The machine-readable medium of claim 21, wherein the attribute is a 3-D position.

25. The machine-readable medium of claim 21, wherein the modified attribute value is overwritten with a default attribute value when an expiration value limit is reached.

26. The machine-readable medium of claim 22, wherein the expiration value limit is a time limit.

27. The machine-readable medium of claim 22, wherein the expiration value limit is related to frequency of object selection.

28. The machine-readable medium of claim 21, wherein the object is a channel selection field.

29. The machine-readable medium of claim 21, wherein the object is a programming time slot field.

30. The machine-readable medium of claim 21, wherein the object is a programming event information field.

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